

**REMARKS**

This is a full and timely response to the outstanding Final Office Action mailed March 23, 2004. Upon entry of the amendments in this response, claims 1 – 2, 4 – 12, 14 – 22, and 24 – 37 remain pending. In particular, Applicants have added claims 31 – 37, and have amended claims 1, 11 and 21. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

**Rejections Under 35 U.S.C. § 102(b)**

The Office Action indicates that claims 1 - 2, 4 - 12, 14 - 22, and 23 - 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Shaughnessy* or *Ng*. For at least the reasons indicated below, Applicants respectfully traverse the rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration.” W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in either the *Shaughnessy* or *Ng* reference. Specifically, claim 1 recites:

1. A system comprising:  
a scanner;  
a document analysis and processing software component in communication with said scanner; and  
***automatic annotation logic in communication with said document analysis and processing software component, said automatic annotation logic configured to detect handwriting in a scanned image and save said handwriting as an annotation in a document generated from said scanned image such that, when a preview image corresponding to the scanned image is displayed to a user via a display device, the annotation is not automatically displayed to the user.***  
(Emphasis Added).

Applicants respectfully assert that neither reference teaches or otherwise discloses at least the features/limitations emphasized above in claim 1. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102 is improper and that claim 1 is in condition for allowance. Since claims 2 – 10 are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance.

Claim 11 recites:

11. A method comprising:  
scanning a document to acquire a scanned image;  
detecting handwriting in said scanned image; and  
***modifying said scanned image to remove said handwriting from the scanned image such that the handwriting is not automatically displayed to an operator viewing the scanned image via a display device, the handwriting being saved as an annotation associated with said scanned image, the annotation being selectively viewable by the operator.***  
(Emphasis Added).

Applicants respectfully assert that neither reference teaches or otherwise discloses at least the features/limitations emphasized above in claim 11. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102 is improper and that claim 11 is in condition for allowance. Since claims 12 and 14 - 20 are dependent claims that incorporate

all the features/limitations of claim 11, Applicants respectfully assert that these claims also are in condition for allowance.

### **Newly Added Claims**

Upon entry of the amendments in this Response, Applicants have added new claims 31 - 37. Applicants respectfully assert that these claims are in condition for allowance for at least the reasons indicated below.

With respect to claim 31, that claim recites:

31. A system for processing a document that includes a notation, said system comprising:  
analysis and processing logic operative to:  
receive information corresponding to a scanned document;  
***determine whether the information comprises a notation; and  
if a notation is identified, process the information such that,  
when a preview image corresponding to the scanned document is displayed  
to the user on a display device, the notation is not automatically displayed to  
the user.***  
(Emphasis Added).

Applicants respectfully assert that the cited art of record, either individually or in combination, is legally deficient for the purpose of anticipating and/or rendering obvious at least the features emphasized above in claim 31. Therefore, Applicants respectfully assert that claim 31 is in condition for allowance. Since claims 32 - 37 depend from claim 31, Applicants respectfully assert that these claims also are in condition for allowance.

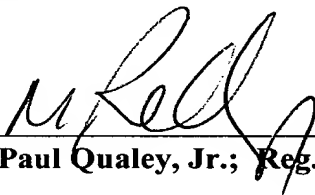
### **Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

**CONCLUSION**

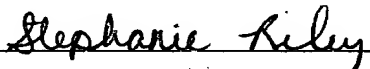
In light of the foregoing amendments, Applicants respectfully submit that pending claims 1 – 2, 4 – 12, 14 – 22, and 24 - 37 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this application, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
\_\_\_\_\_  
M. Paul Qualey, Jr.; Reg. No. 43,024

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
100 Galleria Parkway N.W., Suite 1750  
Atlanta, Georgia 30339  
(770) 933-9500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on

5/6/04  
  
\_\_\_\_\_  
Signature